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INTERNATIONAL BUSINESS MACHINES CORPORATION
Richard Lau
IPLAW DEPARTMENT / Bldg 008-2
2455 SOUTH ROAD - MS P386
POUGHKEEPSIE, NY 12601

EXAMINER
PATEL, DHAIRYA A

ART UNIT	PAPER NUMBER
2451	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

poiplaw2@us.ibm.com

	Application No.	Applicant(s)
	10/730,227	GOODMAN ET AL.
Office Action Summary	Examiner	Art Unit	
	Dhairya A. Patel	2451	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *11 June 2010*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-10 and 30-52* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-10,30-52* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to RCE communication filed on 6/11/2010.

2. This amendment has been considered and entered.   Claims 1-10, 30-52 are
subject to examination.   Claims 11-29 are cancelled.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claim 34, 39, 43 are rejected under 35 U.S.C. 101 because the claimed invention
is directed to non-statutory subject matter

As per claim 34, it states "a computer program product for electronic instant
message...comprising: a storage medium readable by a processing circuit and storing
instructions for execution by the processing circuit for performing a method the steps
of....".   The claim is drawn to "storage medium".   The specification of the current
application is silent regarding the meaning of this term.   Thus applying the broadest
reasonable interpretation in light of the specification, an taking into account the meaning
of the words in their ordinary usage as they would understood by one of ordinary skill in
the art (MPEP 2111), the claim as whole covers both transitory and non-transitory
media.   A transitory medium does not fall into any of the 4 categories of invention
(process, machine, manufacture or composition of matter).

As per claim 39, it states "a computer program product for identifying a message
initiator...comprising: a storage medium readable by a processing circuit and storing
instructions for execution by the processing circuit for performing a method the steps

of....". The claim is drawn to "storage medium". The specification of the current

application is silent regarding the meaning of this term. Thus applying the broadest

reasonable interpretation in light of the specification, an taking into account the meaning

of the words in their ordinary usage as they would understood by one of ordinary skill in

the art (MPEP 2111), the claim as whole covers both transitory and non-transitory

media. A transitory medium does not fall into any of the 4 categories of invention

(process, machine, manufacture or composition of matter).

As per claim 43, it states "a computer program product for electronic instant

message...comprising: a storage medium readable by a processing circuit and storing

instructions for execution by the processing circuit for performing a method the steps

of....". The claim is drawn to "storage medium". The specification of the current

application is silent regarding the meaning of this term. Thus applying the broadest

reasonable interpretation in light of the specification, an taking into account the meaning

of the words in their ordinary usage as they would understood by one of ordinary skill in

the art (MPEP 2111), the claim as whole covers both transitory and non-transitory

media. A transitory medium does not fall into any of the 4 categories of invention

(process, machine, manufacture or composition of matter).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees.   A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163

USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)

may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of

activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

Claims 1,6,10,34,39,43,44,48, 52 provisionally rejected on the ground of

nonstatutory obviousness-type double patenting as being unpatentable over claims 32,

33, 34 of copending Application No. 11/245,577 (hereinafter '577)in view of Appelman

et al. U.S. Patent # 6,539,421 (hereinafter Appelman) in view of Robertson et al. U.S.

Patent # 6,209,100 (hereinafter Robertson)

As per claim 1, 6, 10, of the instant application and claim 32 of '577 application contains similar subject matter as follows:

A method comprising the steps of : receiving at a second unidentified client, a first message to be published from a first client to subscribers including the first client, the first message related to a topic of interest , the first message including a request being directed through a pub/sub service, the second client being a subscriber to the service of the pub/sub service, after receiving said first message at said second client, filtering at said second client the message received from said first client, said filter passing messages of specific interest to said client such that said first message and the included request have to pass the filtering in order for the second client to see the request creating at the second client, a second message, the second message comprising the first message and the first network address said first message in said second message providing context to said second message and including further information pursuant to said specific interest in said first message.

The '577 fails to teach the first client having a first network address as being willing to receive messages related to the topic of interest, second client being anonymous to the first client and other subscribers of the pub/sub service and being unaddressed by the first client and anonymous subscribers known only to said pub/sub service and second client remaining anonymous to the first client and other subscribers after said transmission of said second messages to the first client, transmitting the second message by way of an instant message application from the second client to the

first client, retrieving additional information related to the second client, presenting the

second message and the additional information at the first client.

Appelman teaches the first client having a first network address (column 5 lines

32-42), the first message including a request being directed through a pub/sub service,

the second client being a subscriber to the service of the pub/sub service (column 9

lines 43-67)(Fig. 16-19) as being willing to receive messages related to the topic of

interest (column 2 lines 20-30), transmitting the second message by way of an instant

message application from the second client to the first client (Fig. 16-19) (column 9 lines

30-66); retrieving additional information related to the second client (Fig. 9) (column 6

lines 1-7) (column 5 lines 46-65); and presenting the second message and the

additional information at the first client (Fig. 16-19) (column 9 lines 43-67) (Fig. 9).

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention was made to implement '577 application in the present

application's teaching and Appelman's teaching to come up with having first client

having a network address, and the second client being willing to receive messages

related to the topic of interest. The motivation for doing so would be so a user can

contact the clients/subscribers on the service for their expertise if they are willing to

answer questions related to the topic of interest.

'577 application and Appelman does not teach second client being anonymous to

the first client and other subscribers of the pub/sub service and being unaddressed by

the first client and anonymous subscribers known only to said pub/sub service and

second client remaining anonymous to the first client and other subscribers after said

transmission of said second messages to the first client.

Robertson also teaches first message including a question (i.e. I think the White

Album is brilliant!") related to the topic of interest (i.e. newsgroup) (column 1 lines 49-

57) the second client being a subscriber to the pub/sub service (column 2 lines 47-55)

and being anonymous to the first client and other subscribers of the pub/sub service

and being unaddressed by the first client and anonymous subscribers (i.e. user or

authors) known only to said pub/sub service (i.e. forums) (column 2 lines 47-55) and

second client remaining anonymous to the first client and other subscribers after said

transmission of said second messages to the first client (column 2 lines 61-67)(column

3 lines 1-9)(Fig. 2)(Fig. 3). Robertson also teaches second client being a subscriber to

the service of the pub/sub service as being willing to receive question related to the

topic of interest (column 1 lines 49-67)   It would have been obvious to one of ordinary

skill in the art at the time of applicant's invention was made to implement Robertson's

teaching in Appelman and '577 application's teaching to come up with having

subscribers being anonymous' and second client remaining anonymous to the first client

and other subscribers after said transmission of messages. The motivation for doing so

would be because the user/subscriber wants to remain anonymous to hide his/her

identity therefore any post/messages the user/subscriber sends to the forum, the

system would know the user's actual identity, therefore the user can be traced if

needed.

As per claims 34,39,43 of the instant application, teaches same limitation as claim 33 of '577 application for the reasoning set forth above.

As per claims 44,48,52 of the instant application, teaches same limitation as claim 34 of '577 application for the reasoning set forth above.

This is a <u>provisional</u> obviousness-type double patenting rejection.

Claims 1,6,10,34,39,43,44,48, 52 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 88,89,90 of copending Application No. 10/207,685 (hereinafter '685)in view of Appelman et al. U.S. Patent # 6,539,421 (hereinafter Appelman)

As per claim 1, 6, 10, of the instant application and claim 88 of '685 application contains similar subject matter as follows:

A method for electronic conversation, the method comprising steps of: "receiving a message, first message to be published to subscribers including said first client, the message related to a topic of interest, the first client having a network address, the first message directed through a pub/sub service, the second client being subscriber to the service of the pub/sub service as being willing to receive message related to the topic of interest and being anonymous to the first client and said other subscribers of the pub/sub service and said anonymous subscribers known only to said pub/sub service, filtering at said client the message received from said first client, filtering passing messages of specific interest to said second client such that first message and included request have to pass the filtering.

'685 does not teach creating at the second client, a second message, the second message comprising the first message and the first network address said first message in said second message providing context to said second message and including further information pursuant to said specific interest in said first message, transmitting the second message by way of an instant message application from the second client to the first client; -retrieving additional information related to the second client; presenting the second message and the additional information at the first client.

Appelman teaches creating at the second client, a second message, the second message comprising the first message and the first network address (column 9 lines 43-67) (Fig. 16-19) said first message in said second message providing context to said second message (column 9 lines 43-67) (Fig. 16-19) and including further information pursuant to said specific interest in said first message (Fig. 3 element 135) (column 2 lines 1-11); -transmitting the second message by way of an instant message application from the second client to the first client (Fig. 16-19) (column 9 lines 30-66); -retrieving additional information related to the second client (Fig. 9) (column 6 lines 1-7) (column 5 lines 46-65) -presenting the second message and the additional information at the first client (Fig. 16-19) (column 9 lines 43-67) (Fig. 9),

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Appelman's teaching in '685 application's teaching to come up with having creating at the second client a second message which provides context including further information to specific interest in said first message. The motivation for doing so would be so present an answer back to the user for the

questions which was asked by the user to expert/subscriber willing to receive questions

regarding topic of interest.

As per claims 34,39,43 of the instant application, teaches same limitation as

claim 90 of '685 application for the reasoning set forth above.

As per claims 44,48,52 of the instant application, teaches same limitation as

claim 89 of '685 application for the reasoning set forth above.

This is a <u>provisional</u> obviousness-type double patenting rejection.

Claim Objections

Claim 43 is objected to because of the following informalities: typographical error

for missing "for" in claim 43.

As per claim 43, it states "a computer program product electronic instant

message...". It is missing "for" between "product" and "electronic instant message" .

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4,10,31,33-37,43-46,52 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Appelman et al. U.S. Patent # 6,539,421 (hereinafter Appelman)

in view of Robertson et al. U.S. Patent # 6,209,100 (hereinafter Robertson) in view

of Marks et al. U.S. Patent # 7,596,578 (hereinafter Marks)

As per claim 1, Appelman teaches a method for electronic instant message conversation, the method comprising the steps of:

-receiving at a second unidentified client, a first message to be published from a first client to subscribers including the first client, the first message related to a topic of interest (Fig. 3 element 134)(column 2 lines 1-6), the first client having a first network address (column 5 lines 32-42), the first message including a request being directed through a pub/sub service, the second client being a subscriber to the service of the pub/sub service (column 9 lines 43-67)(Fig. 16-19) as being willing to receive messages related to the topic of interest (column 2 lines 20-30).

NOTE: The reference teaches second user receiving a first message from the first user, through the AIM service (pub/sub service) and receiving the message body and the address of the first client.   The second client (i.e. mjohnson1934 and/or mroe1934) being subscriber to the AIM service (pub/sub service).   The first message including the request in this case is from ("PhillipsJC: Hey did you see the game last night") (Fig. 3 element 134) (i.e. request).   In column 2 lines 20-31, Appelman teaches indicate a willingness to answer question related to the topic of interest.   Appelman shows that PhillipsJC's buddies are currently signed on thus available to receive instant messages (column 2 lines 20-31). The fact that other users/subscribers are signed on, it is obvious that they are available to receive message and therefore answer questions related to their interest.

-creating at the second client, a second message, the second message comprising the first message and the first network address (column 9 lines 43-67) (Fig. 16-19) said first message in said second message providing context to said second message (column 9 lines 43-67) (Fig. 16-19) and including further information pursuant to said specific interest in said first message (Fig. 3 element 135) (column 2 lines 1-11);

NOTE: The reference teaches second user responding, and sending a second message "Hi John" comprising the first message which is "hello Mary" and the first address of "mroe1934" (first network address). The reference teaches first message (Fig. 15 element 604) in second message (Fig. 16 element 614) providing context "hello Mary" in the second message (Fig. 16 element 614). In Fig. 3 element 135 and column 2 lines 1-9, Appelman teaches creating at the second message including an answer to the question contained in said first message. In this case, Frsanfu responds to PhillipsJC question with a response "Unfortunately no, I had to take my dog to the Vet" which means the second message including an answer to the question ("PhillipsJC: Hey did you see the game last night").

-transmitting the second message by way of an instant message application from the second client to the first client (Fig. 16-19) (column 9 lines 30-66);

NOTE: The figures show that second message "Hi john" is sent by instant message application from the second client to the first client.

-retrieving additional information related to the second client (Fig. 9) (column 6 lines 1-7) (column 5 lines 46-65); and

NOTE: The figure 9 shows the entries of the second client "mroe1934" and shows the online status fields (additional information related to the second client).

-presenting the second message and the additional information at the first client (Fig. 16-19) (column 9 lines 43-67) (Fig. 9),

NOTE: The figures presenting the second message "Hi John" with online status field such as time stamp (additional information) at the client in (Fig. 16-19) "13:20:27 mroe 1934" at the client window. The figure teaches sending the message "mroe1934" but the first does not know if mroe1934 received the message.

Appelman fails to teach second client being anonymous to the first client and other subscribers of the pub/sub service and being unaddressed by the first client and anonymous subscribers known only to said pub/sub service and second client remaining anonymous to the first client and other subscribers after said transmission of said second messages to the first client

Robertson also teaches first message including a question (i.e. I think the White Album is brilliant!") related to the topic of interest (i.e. newsgroup) (column 1 lines 49-57) the second client being a subscriber to the pub/sub service (column 2 lines 47-55) and being anonymous to the first client and other subscribers of the pub/sub service and being unaddressed by the first client and anonymous subscribers (i.e. user or authors) known only to said pub/sub service (i.e. forums) (column 2 lines 47-55) and second client remaining anonymous to the first client and other subscribers after said transmission of said second messages to the first client (column 2 lines 61-67)(column 3 lines 1-9)(Fig. 2)(Fig. 3). Robertson also teaches second client being a subscriber to

the service of the pub/sub service as being willing to receive question related to the topic of interest (column 1 lines 49-67)   It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Robertson's teaching in Appelman's teaching to come up with having subscribers being anonymous' and second client remaining anonymous to the first client and other subscribers after said transmission of messages. The motivation for doing so would be because the user/subscriber wants to remain anonymous to hide his/her identity therefore any post/messages the user/subscriber sends to the forum, the system would know the user's actual identity, therefore the user can be traced if needed.

Appelman and Robertson are silent in teaching after receiving said first message at said second client, filtering at said second client the message received from said first client, said filter passing messages of specific interest to said client such that said first message and the included request have to pass the filtering in order for the second client to see the request.

Marks teaches after receiving said first message at said second client (column 6 lines 43-51), filtering at said second client the message received from said first client (column 6 lines 45-51), said filter passing messages of specific interest to said client such that said first message and the included request have to pass the filtering in order for the second client to see the request (column 6 lines 43-60, lines 64-67); in the event that the message passes said filtering at said second client (column 6 lines 43-51) **NOTE**: The reference teaches user inputting the question at a client interface and transmitted via a network to the server. The questioned received by the server are

filtered either automatically or by a human operator (i.e. second client) which then routes the question of specific interested to one of the experts. The questions are filtered by the human operator i.e. second client.   In column 6 lines 64-67, it teaches that expert selects a specific question to answer, and the experts answer the question. This means that questions was filtering with the first message including the request for the client to see, otherwise the expert would not be able to answer the question if he/she did not see the question.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Marks's teaching in Appelman and Robertson's teaching to come up with filtering message at the second client, and said filter passing messages of specific interest to said client and included request for the second client to see the request. The motivation for doing so would be so the second user which is an expert can have an option of whether to answer the question or reject the question if it is non-relevant or redundant question.

As per claim 2, Appelman, Robertson and Marks teaches the method according to claim 1, but Marks further teaches the first message is received at the second client from the first client by way of pub/sub server (i.e. server)(column 6 lines 43-51)

As per claim 3, Appelman, Robertson and Marks teaches the method according to claim 1, Marks further teaches the first message is received at the second client from the first client to a channel of a publish/subscribe server (column 6 lines 28-36, lines 43-51)

Appelman and Marks fails to teach subscribing being authenticated and authorized by said publish/subscribe server anonymous to other of said second or first clients. Robertson teaches subscribing being authorized and authenticated by the publish/subscribe channel anonymous to other of said second for first clients (column 2 lines 13-20, lines 45-67) (column 3 lines 1-13). It would have been obvious to one ordinary skill in the art at the time of applicant's invention was made to implement Robertson's teaching in Appelman and Marks's teaching to come up with subscribing being authenticated and authorized by server unknown to other first or second clients. The motivation for doing so would so that none of the unauthorized user can subscribe to the channel because if one of the user proposes/sends a help question to the particular channel related to a particular area, the user who is not authorized to be in the channel will be prevented from responding or seeing to the help question.

As per claim 4, Appelman, Robertson, and Marks teaches the method according to claim 1, but Appelman further teaches wherein the additional information comprises any one of a first user name, first user title, first user telephone number, first user job responsibility, first user secretary (Fig. 16)(column 25-42); and

NOTE: The reference teaches first user name which "John" or "mroe1934" (first user name).

As per claim 10, Appelman teaches a method for electronic instant message conversation, the method comprising the steps of:

-creating at a first client (Fig. 15 element 600), a first message including a request (Fig. 15 element "Hello Mary") to be published related to a topic of interest (Fig.

3 element 134)(column 2 lines 1-6), the first message comprising any one of additional

information or a link to additional information, the additional information comprising any

one of a user title, a user telephone number, a user value, a user job responsibility or

information about a user's secretary (Fig. 15-16)(column 9 lines 25-42);

NOTE: The reference teaches creating a message the first client a first message

"Hello Mary", the first message comprising the a user value (Fig. 15 element 634

"mroe1934") or a time stamp at what time the message was sent.

-transmitting the first message by way of an instant message application from the

first client to a second client (column 9 lines 25-42) (Fig. 15-16) who has registered with

the pub/sub service as a subscriber to messages related to said topic of interest, the

second client being unaddressed by the first client (Fig. 14) (Fig. 15) (column 9 lines 18-

29),

NOTE: The reference teaches transmitting the first message by instant message

application from first client to the second client.

-retrieving at the second client, the additional information (Fig. 16) (column 25-

42) and said message (Fig. 3 element 134); and

NOTE: The reference teaches at the second client (Fig. 16) receiving (Fig. 16

element "more1934" or "13:20:05" time stamp) (additional information) at the second

client.

-presenting the first message and the additional information and said message

(Fig. 3 element 134) at the second client (Fig. 16) (column 25-42) (column 2 lines 1-9);

NOTE: The figure 16 teaches presenting the first message "Hello Mary" and the additional information (13:20:05 or mroe1934), which is a time stamp and a user value.

-second message including an answer to the question including in said first message (Fig. 3 element 135) (column 2 lines 1-10).

Appelman fails to teach second client being known only to said pub/sub service and being anonymous to said first client and to other subscribers of said pub/sub service; and transmitting a second message from the second client to the first client said second client remaining anonymous to the first client and other subscribers of said pub/sub service after said second message is transmitted to said first client.

Robertson teaches second client being known only to said pub/sub service and being anonymous to said first client and to other subscribers of said pub/sub service; and transmitting a second message from the second client to the first client said second client remaining anonymous to the first client and other subscribers of said pub/sub service after said second message is transmitted to said first client (column 2 lines 45-67)(column 3 lines 1-9)(Fig. 2)(Fig. 3) second message including an answer ("I agree with you!") to the question ("I think the white album is brilliant") including in said first message (column 1 lines 47-59). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Robertson's teaching in Appelman's teaching to come up with having second client being known only to said pub/sub service and being anonymous to said first client and to other subscribers of said pub/sub service. The motivation for doing so would be because the user/subscriber wants to remain anonymous to hide his/her identity therefore any

post/messages the user/subscriber sends to the forum, the system would know the user's actual identity, therefore the user can be traced if needed and also to send or propose a help question to people in the channel and having other people in the channel responds with the answer from the channel.

Appelman and Robertson are silent in teaching after receiving said first message at said second client, filtering at the second client said received message for messages of specific interest to said second client such that said first message and the included request have to pass the filtering in order for the second client to see the request; in the event that the message passes said filtering as being of specific interest to said second client.

Marks after receiving said first message at said second client (column 6 lines 43-51), filtering at the second client said received message for messages of specific interest to said second client such that said first message and the included request have to pass the filtering in order for the second client to see the request (column 6 lines 43-60, lines 64-67); in the event that the message passes said filtering as being of specific interest to said second client (column 6 lines 43-51). **NOTE**: The reference teaches user inputting the question at a client interface and transmitted via a network to the server. The questioned received by the server are filtered either automatically or by a human operator (i.e. second client) which then routes the question of specific interested to one of the experts. The questions are filtered by the human operator i.e. second client.   In column 6 lines 64-67, it teaches that expert selects a specific question to answer, and the experts answer the question. This means that questions was filtering with the first

message including the request for the client to see, otherwise the expert would not be able to answer the question if he/she did not see the question.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Marks's teaching in Appelman and Robertson's teaching to come up with filtering messages at the client such that second client does not receive message if the message does not pass the filtering, and filtering passing messages of specific interest at the second client. The motivation for doing so would be so that experts are not riddled with repeated questions, unanswerable questions, or questions outside of their expertise (paragraph 21).

As per claim 31, Appelman, Robertson and Marks teaches the method according to claim 4, but Appelman further teaches wherein the additional information further consists of any one of a first user address, a first user value, a text file, a video file, an audio file or a network link (such as a URL). (Fig. 15-16)(column 9 lines 25-42);

NOTE: The reference teaches the additional information a user value or a first user address (Fig. 15 element 634 "mroe1934") or a time stamp at what time the message was sent.

As per claim 33, Appelman, Robertson and Marks teaches the method according to claim 10, but Appelman further teaches wherein the additional information further consists of any one of a first user address, a first user value, a text file, a video file, an audio file or a network link such as a URL, a telephone message or command information for actuating a mechanical a device. (Fig. 15-16)(column 9 lines 25-42);

NOTE: The reference teaches the additional information a user value or a first user address (Fig. 15 element 634 "mroe1934") or a time stamp at what time the message was sent.

As per claims 34-37 respectively, teaches same limitations as claims 1-4 respectively, therefore rejected under same basis.

As per claim 43,52 respectively, teaches same limitations as claim 10 respectively, therefore rejected under same basis.

As per claims 44-46 respectively, teaches same limitations as claims 1-2,4 respectively, therefore rejected under same basis.

Claims 6-9,39-42,48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman et al. U.S. Patent # 6,539,421 (hereinafter Appelman) in view of Marks further in view of Robertson et al. U.S. Patent # 6,209,100 (hereinafter Robertson)

As per claim 6, Appelman teaches a method for identifying a message initiator in a system for instant message, the method comprising the steps of:

-obtaining at a first client, first user identifying information (column 5 lines 46-65) (column 6 lines 1-6) (Fig. 9); **NOTE:** The figure teaches obtaining at the first client, the buddy list and the information about the first user identifying information "mroe1934" and his online status field.

-incorporating the first user identifying information in a message to be published (Fig. 16-19) (column 9 lines 43-67) (Fig. 9) said message including a question related to the topic of interest (Fig. 3 element 134) (column 2 lines 1-6). **NOTE:** The figures

presenting "mroe1934" and his online status field such as time stamp (first user identifying information) in the message at the first client in (Fig. 16-19) "13:20:05 mroe1934" to be published.

-transmitting the message; publishing the message to subscribers (column 9 lines 25-42) (Fig. 15-16)

Appelman fails to teach a pub/sub server, i.e. transmitting the message to a pub/sub server; publishing the message including a request to subscribers of the pub/sub server said subscribers being anonymous to said first user and other subscribers and being authenticated and authorized by said pub/sub server; and providing the message comprising the first user information to a subscriber who remains anonymous to said first user and said anonymous subscribers being known only to pub/sub server; and said second user subscriber remaining anonymous to said first user and other subscribers after the second message is transmitted to said first user; after receiving said message at said subscribers, filtering at each subscriber said published message for filtering said messages and included requests for messages of specific interest to the respective subscribers such that said messages and included requests have to pass the filtering in order for the subscribers to see the request; providing the filtered message comprising the first user information and said message related to the topic of interest and filtered to be of specific interest to a second user subscriber who remains anonymous to said first user; transmitting a second message responsive to said published message and including further information pursuant to said specific interest in said first message from a second user subscriber directly to the first

user, and said second user subscriber remaining anonymous to said first user and other
subscribers after the second message is transmitted to said first user.

Marks teaches a pub/sub server(i.e. server) (Fig. 1 element 114) transmitting the
message to a pub/sub server (column 6 lines 45-47); publishing the message including
a request to subscribers (i.e. experts) of the pub/sub server subscribing to messages
related to said specific topic (i.e. expertise topic) (column 6 lines 43-53)

Marks also teaches after receiving said message at said subscribers (column 6
lines 43-51), filtering at each subscriber said published message for filtering said
messages and included requests for messages of specific interest to the respective
subscribers such that said messages and included requests have to pass the filtering in
order for the subscribers to see the request (column 6 lines 43-60, lines 64-67)

-providing the filtered message comprising the first user information and said
question message related to the topic of interest (column 7 lines 29-36) and filtered to
be of specific interest to a second user subscriber (column 6 lines 47-54), transmitting a
second message responsive to said published message (column 6 lines 65-67) (column
7 lines 1-5) and including further information pursuant to said specific interest in said
first message from a second user subscriber directly to the first user (column 11 lines
38-47).

It would have been obvious to one of ordinary skill in the art at the time of
applicant's invention was made to implement Marks's teaching in Appelman's teaching
to come up with filtering message at the second client, and said filter passing messages
of specific interest to said client and included request for the second client to see the

request. The motivation for doing so would be so the second user which is an expert can have an option of whether to answer the question or reject the question if it is non-relevant or redundant question.

Appelman and Marks fails to teach subscribers being authenticated and authorized by said pub/sub server.

Robertson subscribers being authenticated and authorized by said pub/sub server and subscribers being anonymous to said first user and other subscribers (column 2 lines 13-20, lines 45-67)(column 3 lines 1-13) said anonymous subscribers being only to pub/sub server (column 2 lines 47-55); and second user subscriber remaining anonymous to said first user and other subscribers after the second message is transmitted to said first user (column 2 lines 61-67)(column 3 lines 1-9)(Fig. 2)(Fig. 3).

It would have been obvious to one ordinary skill in the art at the time of applicant's invention was made to implement Robertson's teaching in Appelman and Marks's teaching to come up with subscribing being authenticated and authorized by server unknown to other first or second clients and subscribers being anonymous to pub/sub server and second client remaining anonymous to the first client. The motivation for doing so would be so that none of the unauthorized user can subscribe to the channel because if one of the user proposes/sends a help question to the particular channel related to a particular area, the user who is not authorized to be in the channel will be prevented from responding or seeing to the help question and the user/subscriber wants to remain anonymous to hide his/her identity therefore any

post/messages the user/subscriber sends to the forum, the system would know the user's actual identity, therefore the user can be traced if needed.

As per claim 7, Appelman, Marks and Robertson teaches the method according to claim 6 but Appelman further teaches wherein the providing step comprises the further steps of: acquiring second user information based on the first user identifying information in the message (Fig. 9)(column 6 lines 1-7)(column 5 lines 46-65); and

NOTE: The figure 9 shows the entries of the second client "mroe1934" and shows the online status fields (additional information related to the second client).

-providing the second user information to the subscriber (Fig. 16-19) (column 9 lines 43-67) (Fig. 9).

As per claim 8, Appelman, Marks and Robertson teaches the method according to claim 6 but Appelman further teaches wherein the obtaining step comprises the further step of: transforming user information from any one of instant message, text, audio, video or voice into the digital message (column 2 lines 36-38)

As per claim 9, Appelman, Marks and Robertson teaches the method according to claim 6 but Appelman further teaches wherein the presenting step comprises the further step of: transforming the message to any one of instant message, text, audio or video (Fig. 16-19) **NOTE:** The reference teaches the transforming the message into instant message.

As per claims 39-42 respectively, teaches same limitations as claims 6-9 respectively, therefore rejected under same basis.

As per claims 48-51 respectively, teaches same limitations as claims 6-9 respectively, therefore rejected under same basis.

Claims 5,30,32,38,47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelman et al. U.S. Patent # 6,539,421 (hereinafter Appelman) in view of Robertson et al. U.S. Patent # 6,209,100 (hereinafter Robertson) further in view of Marks further in view of Kapil et al. U.S. Patent # 6,941,345 (hereinafter Kapil)

As per claim 5, Appelman, Robertson, Marks teaches the method according to claim 1 but fails to teach wherein any one of the first message or the second message is translated to any one of a telephone message, a video display, an audio message or a mechanical actuator. Kapil teaches any one of the first message or the second message is translated to any one of a telephone message, a video display, an audio message or a mechanical actuator (Column 5 lines 52-64)(column 6 lines 12-20). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman, Robertson, Marks's teaches to come up with having first message or second message translated into any one of telephone message, a video display an audio message. The motivation for doing so would have been so that if the user does not have access to a computer to receive the first message or second message, he/she can still receive by a telephone message or audio message.

As per claim 30, Appelman, Robertson and Marks teaches the method according to claim 1, but Marks teaches comprising the further steps of: associating the second

client with a channel of a publish/subscribe server (i.e. "server")(Fig. 1 element

114)(column 6 lines 29-33, lines 43-53); the first client sending the first message to the

channel of the publish/subscribe server (column 6 lines 43-53); and the

publish/subscribe server publishing the first message to the determined plurality of

subscribers (column 6 lines 45-60).

Appelman, Robertson and Marks are silent in teaching determining network

addresses of a plurality of subscribers associated with the channel, the plurality of

subscribers associated with the channel comprising the second client.

Kapil teaches determining network addresses of a plurality of subscribers

associated with the channel, the plurality of subscribers associated with the channel

comprising the second client (column 12 lines 33-51). Kapil also teaches associating

the second client with a channel of a publish/subscribe server (column 12 lines 9-32);

the first client sending the first message to the channel of the publish/subscribe server

(column 4 lines 16-49); the publish/subscribe server publishing the first message to the

determined plurality of subscribers (column 4 lines 16-49) (column 12 lines 9-51).

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention was made to implement Kapil's teaching in Appelman, Robertson

and Marks's teaching to come up with determining network address of the plurality of

subscribers associated w/ the channel. The motivation for doing so would have been so

that first user can check through the service provider in the community (pub/sub server)

that the plurality of users exists and send a message, and if the plurality of users can

have a conversation with the first user.

Appelman, Marks and Kapil fails to teach second client being authenticated and authorized by said publish/subscribe server. Robertson teaches second client being authorized and authenticated by the publish/subscribe channel (column 2 lines 13-20, lines 45-67) (column 3 lines 1-13). It would have been obvious to one ordinary skill in the art at the time of applicant's invention was made to implement Robertson's teaching in Appelman, Marks and Kapil's teaching to come up with second client being authenticated and authorized by server. The motivation for doing so would be so that none of the unauthorized user can subscribe to the forum because if one of the user proposes/sends a help question to the particular channel related to a particular area, the user who is not authorized to be in the forum will be prevented from responding or seeing to the help question.

As per claim 32, Appelman, Robertson, Marks teach the method according to claim 6, but Marks further teaches wherein the transmitting step comprises the further steps of: the first client associating the first message to be transmitted with a channel of the pub/sub server (i.e. "server")(Fig. 1 element 114)(column 6 lines 29-33, lines 43-53); the pub/sub server receiving the first message from the first client (column 6 lines 43-53); wherein the publishing step comprises the further step of publishing the first message to the plurality of subscribers associated with the channel of the pub/sub server (column 6 lines 43-60)

Appelman, Robertson, Marks are silent in teaching the pub/sub server determining network addresses of a plurality of subscribers associated with the channel, the plurality of subscribers associated with the channel comprising the second client.

Kapil teaches pub/sub server determining network addresses of a plurality of subscribers associated with the channel, the plurality of subscribers associated with the channel comprising the second client (column 12 lines 33-51)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to implement Kapil's teaching in Appelman, Robertson and Marks's teaching to come up with determining network address of the plurality of subscribers associated w/ the channel. The motivation for doing so would have been so that first user can check through the service provider in the community (pub/sub server) that the plurality of users exists and send a message, and if the plurality of users can have a conversation with the first user.

As per claim 38, 47, teaches same limitations as claim 5, therefore rejected under same basis.

Response to arguments

Applicant's arguments with respect to claims 1-10,30-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A). "Voice Instant messaging" by Wu et al. U.S. Patent Publication # 2002/0023131 A1.

B) "Video Messaging" by Enete et al. U.S. Patent Publication # 2003/0208543 A1.

A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the applicant (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhairya A. Patel whose telephone number is 571-272-5809. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAP

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451